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| K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690 | | | | |
| EXAMINER | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,766

Applicant(s)

KINDERMANN, ROBERT

Examiner

MOHAMED IBRAHIM

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Response to Amendment

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a computer program which is software per se. Since software programs are not one of the categories of patentable subject matter, the claims are found to be directed to non-patentable subject matter. The claims as currently amended only state the intended use of the computer which is to store a program; however, the program needs to be actually stored on the computer or some sort of computer readable storage medium (having support from the specification).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Shimoosawa, U. S. Patent No. 6658456 in view of Appelman et al. (Appelman), U. S. Patent No. 6912564.

Regarding claim 1, Shimoosawa discloses a method for establishing a connection between a first and a second subscriber of a telecommunications network (see e.g. fig. 6 and col. 4 lines 3-8; a public switched telephone network), comprising: creating an object intended for use on a computer at the second subscriber side of the telecommunications network (see e.g. col. 1 lines 57-61; receiving an e-mail from another computer on the network); inserting an address assigned to the second subscriber in the telecommunications network (see e.g. col. 4 lines 57-65; e-mail address is required in order to compose emails); transferring the object to the first subscriber; storing the object on the computer of the first subscriber(see e.g. col. 8 lines 22-33; e-mail transmission and storage units are provided); reading out, with aid of a function which is activated by the first subscriber, the address assigned to the second subscriber in the telecommunications network (see e.g. col. 10 lines 3-4; received e-mail is activated or read); and establishing the connection between first and second subscriber with aid of the address, wherein the address assigned to the second subscriber in the telecommunications network is added as an attribute to the content of the object and is read out (see e.g. col. 5 lines 20-44; the transfer determination unit carries out a matching in the transfer management table for the e-mail address which the received e-mail from the sender was destined).

Although Shimoosawa discloses the invention substantially as claimed, it does not explicitly disclose real-time communication.

Appelman teaches system for instant messaging the sender and recipient of an e-mail message. In this system, a recipient of an email message can respond to the sender by

establishing real time communication with the sender by sending instant messaging to the sender (see Appelman, fig. 10 and col. 14 lines 2-33). At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the teaching of Appelman with that of Shimoosawa. Motivation for doing so would have been to provide immediate and real time access to desired information (see Appelman, col. 1 lines 34-35)..

Claim 2 is substantially the same as claim 1 and is thus rejected for reasons similar to those in rejecting claim 1. Furthermore Shimoosawa-Appelman teaches determining with aid of a function which is activated by the subscriber, the address assigned to the second subscriber in the telecommunication network using the identification included in the object (see e.g. col. 5 lines 39-63). The same motivation utilized in the combination of claim 1, equally applies as well to claim 2.

Regarding claim 3, Shimoosawa-Appelman teaches wherein the identification included in the attribute of the object is transferred in the telecommunications network using the function activated by the first subscriber, the address of the second subscriber is determined based on the identification and the connection to the second subscriber is established (see e.g. col. 6 lines 25-37).

Regarding claim 4, Shimoosawa-Appelman teaches wherein an e-mail is provided as the object, an e-mail address of the second subscriber is included as the identification,

and the address of the second subscriber in the telecommunications network is determined based on the e-mail address (see e.g. col. 5 lines 20-28 and col. 6 lines 17-23).

Regarding claim 5, the limitation of claim 5 is substantially same as that of claim 1 and thus is rejected for reasons similar to that on claim 1. The same motivation utilized in the combination of claim 1, equally applies as well to claim 5.

Claim 6 list some the same elements of claim 1, but in computer form rather than method form. Therefore, the supporting rationale of the rejection to claim 1 applies equally as well to claim 6. The same motivation utilized in the combination of claim 1, equally applies as well to claim 6.

Response to Arguments

3. Applicant's arguments filed 12/17/2008 have been fully considered but they are not persuasive.

Applicant, in substance, argues that the object is not created at the second subscriber side of the telecommunications network.

In response, the lack of more precise definition of the term "object", the examiner interprets the term object to include email or email attachment. In that regard, Shimoosawa discloses the creation of an e-mail by a second computer in the

telecommunications network which is transmitted and received by the first computer (see fig. 7, col. 1 lines 57-61 and col. 4 lines 46-54). Thus the applied prior art of record still meets the required scope of the claimed limitation as currently recited.

Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as reasonable.

Applicant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

Prior Art of Record

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MOHAMED IBRAHIM** whose telephone number is (571)270-1132. The examiner can normally be reached on Monday through Friday from 7:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn, Jr. can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/
Primary Examiner, Art Unit 2444

/Mohamed Ibrahim/
Examiner, Art Unit 2444